

REMARKS

This Amendment accompanies a Request for Continued Examination (RCE). Entry of this Amendment is respectfully requested.

Claims 1-14, 16, 17 and 19-26 are pending in this application, of which claims 1, 2, 4-14, 16, 17 and 19-22 have been rejected and claims 23-26 are newly added herein. Dependent claim 3 has withdrawn from consideration in paragraph 1 of the Office Action. It is respectfully submitted that claim 3 should be allowable upon allowance of an independent generic claim. M.P.E.P §821.04. Claims 1, 9, 10, 14, 17 and 21 have been amended to correspond with the explicit embodiment of the invention illustrated in the drawings of the present application. The button (4) is mounted upon the lower cover 3 in the drawings. Claims 23-26 introduced herein also find support throughout the present application and the drawings.

The Rejections

1. Claims 1 and 10-12 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,170,651 ("Taormina").

The present invention explicitly provides an eyeglass case 1 in which contents, i.e., eyeglasses, can be removed in a single step by the same hand. To this end, the inventive eyeglass case 1 comprises an upper cover 2, a lower cover 3, a button 4 secured to the lower cover 3, and a rotating member 6 secured to a contact portion between the upper and lower covers 2,3. More explicitly, the rotating member 6 is arranged on the eyeglass case 1 such that when the button 3 is pushed for release, a spring, rotor or vane 8 in the rotating member 6 moves to slowly open the upper cover 2 upwardly away from the lower cover 3 and allow contents within the case 1 to be directly retrieved in a single step by the same hand or member depressing the button 4.

In a preferred embodiment, the rotating member 6 has a support spindle 7 for the spring 8 and outer housing for containing the support spindle 7, with oil 9 being sealed within the support spindle 7 (Claim 2); preferably, the oil 9 is positioned throughout an interior of the rotating member 6, and about the spring, vane or rotor 8 positioned therewithin (Claim 22).

The features of the presently claimed invention together with the accompanying advantages attained thereby, are neither disclosed nor suggested by Taormina for the following reasons.

Taormina discloses an eyeglass container 10 having a cylindrical shape (i.e., not an oblong shape as recited, e.g., in Claim 21) and designed to contain a multiple of items, e.g., eyeglasses 24 and a tube 58 of cleaning solution which is removed from the end 32 of the case body 12 opposite the end 22 from which the eyeglasses 24 are removed (Figs. 1 and 2). Accordingly, unlike the presently claimed invention, it is not possible in Taormina to both open the eyeglass case 12 and directly retrieve the eyeglasses 24 in a single step and with the same hand; the eyeglass case 12 in Taormina must either be placed on a surface or held by the other hand after opening, to remove the eyeglasses 24. By the same token, inserting the eyeglasses 24 back into the case 12 in Taormina cannot be accomplished in a single step with just one hand.

In the first full paragraph on page 7 the Office Action states:

Contrary to applicant's argument it is possible to both open the eyeglass case of Taormina remove the eyeglasses in a single step and with the same hand by pushing on button 52 while tilting the eyeglass case, which will inherently force the eyeglasses out of the eyeglass case.

The Office Action equates tilting an eyeglass case and allowing the contents to fall out under the force of gravity with removal of the contents by the same hand which opens the eyeglasses case. While applicant disagrees with such an interpretation, claim 1 is amended herein to recite "directly retrieved" instead of "removed" to render the distinction more clear. With respect to the obviousness rejection of Claims 8 and 9 over Taormina, notably the comment in the first full paragraph on page 5 of the Office Action, it is respectfully pointed out criticality of the explicitly claimed arrangement has indeed been shown to permit opening of the eyeglass case 1 in a single step with just a single, e.g., the same hand. Therefore, Taormina also fails to render obvious the invention recited in any pending claim.

Accordingly, it is respectfully submitted that Claim 1 and all claims depending therefrom are neither anticipated nor suggested by Taormina. Reconsideration and withdrawal of the rejection are respectfully requested.

2. Claims 8, 9 and 21 are rejected under 35 U.S.C. §103(a) as being obvious over Taormina.

These claims depend from claim 1 and are therefore submitted to be allowable for the reasons stated above. However, additionally with respect to the obviousness rejection of Claims 8, 9 and 21 over Taormina, it is respectfully pointed out criticality of the explicitly claimed arrangement has indeed been shown to permit opening of the eyeglass case 1 in a single step with just a single, e.g., the same hand. Therefore, Taormina also fails to render obvious the invention recited in any pending claim.

With respect to claim 21, the hinge 52 of Taormina is not oriented along a longer side 18 of the case 12, as recited in amended claim 21. Rather, the hinge is oriented transverse to the longer side, which provides a completely different opening operation. As can be seen from Fig. 1 of Taormina, case 12 opens transverse to the lengthwise axis of the case. In contrast to this, Applicant's case 1 opens along the length of the case such that hinge 6 with rotating member is oriented with and extends lengthwise along one of the longer sides. See, e.g., Applicant's Figs 1 and 5. Taormina neither discloses nor suggests such a feature.

Accordingly, claims 8, 9, and 21 are neither disclosed nor suggested by Taormina. Reconsideration and withdrawal of the rejection are respectfully requested.

3. Claims 2, 4-7, 13-14, 16-17, 19-20 and 22 are rejected under 35 U.S.C. §103(a) as being obvious over Taormina in view of U.S. Pub. No. 2003/0201265 ("Lin").

Concerning the rejection of Claims 2, 4-7 and 13-20 additionally in view of Lin, this patent publication just discloses oil being positioned between internal 31 and external 32 tubes of slow pivot element 30 to dampen rotation of cover 20 on garbage bin 1 (page 2, column 2,

paragraph [0041]). There is no suggestion of arranging this pivoting mechanism of Lin on an eyeglass case. Accordingly, the only teaching of arranging components in the manner of Claims 2, 4-7 and 13-20 can be found in the present application itself, so any combination of Taormina and Lin, at most, constitutes improper hindsight reconstruction in light of the disclosure in the present application.

Furthermore, as pointed out *supra*, Lin discloses oil situated between inner and outer tubes 31, 32 and fails to teach presence of oil 9 throughout an interior of a rotating member 6 and about the spring, rotor or vane 8 positioned therewithin (please see, e.g., Claim 22). Accordingly, Lin fails to add anything to Taormina which would render obvious the invention recited in any claim.

In the Response to Arguments the Office Action states:

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See, *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

However, rejections must be based upon the objective evidence of record. *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Particular findings must be made as to the reason the skilled artisan, *with no knowledge of the claimed invention*, would have selected the components for combination in the manner claimed. See, *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). The factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority. *In re Lee* at 1434. The Examiner is obliged to develop an evidentiary basis for supporting rejections. Deficiencies in the cited references cannot be remedied by conclusory statements. See, *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

In the present instance, Neither Taormina nor Lin suggests the combination of their teachings. Accordingly it is respectfully submitted that these references do not support a *prima*

facie case for obviousness. Reconsideration and withdrawal of the rejection are respectfully requested.

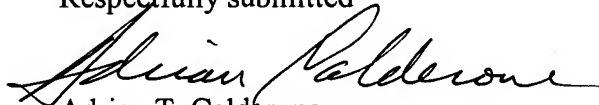
The New Claims

New claims 23 to 26 are added herein and are also submitted to be allowable over the cited prior art.

CONCLUSION

For at least the reasons stated above all of the pending claims are submitted to be in condition for allowance, the same being respectfully requested. The requisite fees for filing a Request for Continued Examination (RCE) and additional claims are enclosed, together with the RCE transmittal papers.

Respectfully submitted



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